



AF\$  
IFW

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q64130

Takashi TAKENAGA

Appln. No.: 09/850,114

Group Art Unit: 2141

Confirmation No.: 9597

Examiner: Bayard, Djenane M.

Filed: May 08, 2001

For: SYSTEM AND METHOD FOR INCORPORATING AD INFORMATION INTO AN  
E-MAIL

**SUBMISSION OF APPEAL BRIEF**

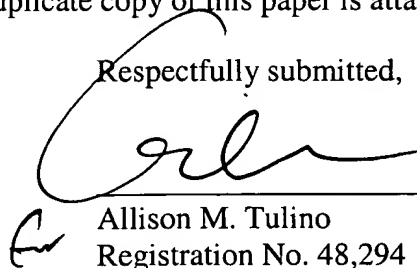
**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of \$500.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

  
Allison M. Tulino  
Registration No. 48,294

Reg. No.  
41,278

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: June 6, 2005



**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q64130

Takashi TAKENAGA

Appln. No.: 09/850,114

Group Art Unit: 2141

Confirmation No.: 9597

Examiner: Bayard, Djenane M.

Filed: May 08, 2001

For: SYSTEM AND METHOD FOR INCORPORATING AD INFORMATION INTO AN  
E-MAIL

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

**Table of Contents**

I.	REAL PARTY IN INTEREST .....	2
II.	RELATED APPEALS AND INTERFERENCES .....	3
III.	STATUS OF CLAIMS .....	4
IV.	STATUS OF AMENDMENTS .....	5
V.	SUMMARY OF THE CLAIMED SUBJECT MATTER .....	6
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL .....	15
VII.	ARGUMENT .....	16
	CLAIMS APPENDIX .....	28
	EVIDENCE APPENDIX: .....	33
	RELATED PROCEEDINGS APPENDIX .....	34

**I. REAL PARTY IN INTEREST**

The real party in interest is Pioneer Corporation, of Tokyo, Japan, by virtue of an assignment executed by Takashi Takenaga on April 10, 2001. The assignment was recorded on May 8, 2001, at Reel 011782, Frame 0268.

## **II. RELATED APPEALS AND INTERFERENCES**

To the best of the knowledge and belief of Appellant, Appellant's legal representatives, and the assignee in this application, there are no other pending appeals or interferences before the Board of Appeals and Interferences (hereinafter "the Board") that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant Appeal.

### **III. STATUS OF CLAIMS**

Claims 1-13 are all of the claims currently pending in the present application. Currently, claims 1-13 stand rejected by the Examiner, which are the subject of this appeal.

**IV. STATUS OF AMENDMENTS**

An Amendment under 37 C.F.R. § 1.111 was filed on November 13, 2004, in response to the Office Action dated August 24, 2004. There are no outstanding, non-entered amendments of the claims.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Appellant's invention relates to a system and a method for incorporating advertising information into e-mails. As a matter of example to more fully explain the invention, Appellant will describe the features shown in the exemplary embodiments of the invention, which are described in detail on pages 11-18 of the specification. Portions of the claims that correspond to the features shown in the exemplary embodiments are also referenced during this discussion. However, this discussion of the exemplary embodiments and the pending claims is provided for explanatory purposes only, and is not intended to limit the scope of the claims in any way.

In recent years, the use of electronic mail ("e-mail") as a means for transmitting information has become widespread. E-mail services provide a means by which transmitting and receiving terminals, such as microcomputers, can exchange text or voice information in the form of electronic messages via a network.

Conventional e-mail systems transmit e-mail messages to a receiving terminal "as is," i.e., e-mail messages are transmitted to and received by a receiving terminal with no additional content inserted into the messages. However, it would be advantageous to provide an e-mail receiving terminal with highly effective ads incorporated into the e-mails that the receiving terminal receives.

One illustrative and non-limiting embodiment of the present invention attempts to achieve the above advantages (and others) by providing a system for incorporating ad information into e-mails, wherein the ad information is retrieved based on area information that

is contained in the initially transmitted e-mail message. (*See* page 2, line 15 – page 3, line 12; page 4, lines 2-8). As the specification makes clear, such area information that is contained in an e-mail message may include but is not limited to, for example, information regarding a geographic area such as a map, traffic facilities, or an address, which is inserted in addition to the body of an e-mail message. (Page 13, lines 4-8; page 14, lines 4-12). Accordingly, ad information such as banner ads, etc., for instance, that correspond to the specific area information contained in a particular e-mail are inserted into the e-mail and transmitted to a receiving terminal, where the ad information is displayed together with the e-mail body and area information. (Page 4, lines 9-20).

By way of illustration, one exemplary embodiment provides a system for incorporating ad information into e-mails comprising an e-mail site S1 connected to the internet 1. (Page 11, line 24 – page 12, line 2; Figure 1). As shown in Figure 2, the e-mail site S1 includes an e-mail server S1a for saving an e-mail message transmitted from a sending terminal (e.g., T2) to a receiving terminal (e.g., T1) according to a transmission request made by the receiving terminal (e.g., T1). (Page 12, lines 18-22; Figure 2).

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language below:



1. (previously presented): A system for incorporating ad information into e-mails, comprising:

at an e-mail site including an e-mail server for saving an e-mail transmitted from a sending terminal and transmitting the e-mail to a receiving terminal based on a transmission request made by the receiving terminal...

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site including an e-mail server for saving an e-mail transmitted from a sending terminal and transmitting the e-mail to a receiving terminal based on a transmission request made by the receiving terminal...

As shown in Figure 5, an e-mail message M transmitted from a sending terminal (e.g., T2) to a receiving terminal (e.g., T1), for instance, contains an e-mail body entry column *a* and an area information display column *b*. (Page 14, lines 4-6; Figure 5). According to this exemplary embodiment, the area information display column *b* of e-mail message M includes area information such as a map, traffic facilities, and/or an address of a desired area that the sender of the e-mail message M has obtained. (Page 14, lines 7-9; Figure 5). Further, such area information may be obtained, for example, from the area information provision site S2 equipped with a WWW server and the area information database site S3. (Page 13, lines 4-6; page 14, lines 7-12; Figure 1).

Thus, according to this particular embodiment, after the e-mail server S1a receives the e-mail message M transmitted from a sending terminal (e.g., T2) to a receiving terminal (e.g., T1),

the e-mail server S1a determines whether the e-mail message M contains area information in the area information display column *b* or not. (Page 14, lines 29).

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language below:

1. (previously presented): A system for incorporating ad information into e-mails, comprising:

...an area information detector for detecting whether an e-mail transmitted from the sending terminal contains area information or not...

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site... comprising the steps of:

...detecting whether an e-mail transmitted from the sending terminal contains area information...

Therefore, according to the exemplary embodiment under discussion, if the e-mail message M contains area information in the area information display column *b*, then the e-mail server S1a accesses the position information database S1c, which stores position information such as a latitude and longitude range, as shown in Figure 3. (Page 14, line 24 – page 15, line 5; Figure 3). Further, position information stored in database S1c corresponds to the area information (e.g., a map of a city, traffic facilities, or an address) contained in the display column *b* of the e-mail message M, and indicates the display range of such area information. (Page 14 line 24 – page 15, line 5).

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language below:

1. (previously presented): A system for incorporating ad information into e-mails, comprising:

...a position information database that stores position information indicating the display range of area information displayed in the e-mail...

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site... comprising the steps of:

...retrieving ...from a position information database that stores position information indicating a display range of area information when it is detected that area information is contained in the e-mail...

Thus, according to this exemplary embodiment, if the e-mail message M contains area information, then the e-mail server S1a also accesses the ad information database S1d, which stores ad information and position information. (Page 15, lines 6-12). Moreover, as shown in Figure 4, the position information stored in the ad information database S1d corresponds to the ad information and may comprise, for example, a latitude and longitude range of an ad provider. (Page 15, lines 6-12; Figure 4).

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language below:

1. (previously presented): A system for incorporating ad information into e-mails, comprising:

...an ad information database where ad information containing ad data and position data of an ad provider is stored...

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site... comprising the steps of:

...retrieving... from an ad information database, where ad information containing ad data and position data of an ad provider is stored, the retrieved ad information being based on the position data and the position information of said retrieved area information...

Accordingly, consistent with the exemplary embodiment under discussion, when an e-mail message M contains area information, the e-mail server S1a retrieves position information (e.g., a latitude and longitude range) from the position information database S1c, and the retrieved position information corresponds to the area information. (Page 14, line 24 – page 15, line 5).

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language below:

1. (previously presented): A system for incorporating ad information into e-mails, comprising:

...an ad information inserting section for:  
retrieving position information on the area information from said position information database when it is detected that the e-mail contains area information...

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site... comprising the steps of:

...retrieving position information corresponding to the area information contained in the e-mail from a position information database that stores position information indicating a display range of area information when it is detected that area information is contained in the e-mail...

In accordance with this particular exemplary embodiment, the e-mail server S1a also retrieves ad information from the ad information database S1d. (Page 15, lines 6-7). Moreover, the e-mail server S1a retrieves such ad information based on the position data (e.g., the latitude and longitude range) of the ad information. (Page 15, lines 6-12). In particular, the position (e.g., the latitude and longitude range) of the ad information that is retrieved by the e-mail server S1a is contained in the display range (e.g., the latitude and longitude range) of the area information that is contained in the e-mail message M. (Page 15, lines 6-12). And, the display range of the area information that is contained in the e-mail message M is indicated by the position information (e.g., a latitude and longitude range) that the e-mail server S1a retrieves from the position information database S1c, as already discussed above. (Page 14, line 24 – page 15, line 5; page 15, lines 6-12).

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language below:

1. (previously presented): A system for incorporating ad information into e-mails, comprising:

...an ad information inserting section for:...

...retrieving, from said ad information database, ad information positioned in the display range of the area information indicated by the retrieved position information, based on the position data of ad information...

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site... comprising the steps of:

...retrieving ad information positioned in the display range of said area information from an ad information database, where ad information containing ad data and position data of an ad provider is stored, the retrieved ad information being based on the position data and the position information of said retrieved area information; and...

Hence, according to the exemplary embodiment under discussion, the e-mail server S1a inserts into the e-mail message M, the ad data (e.g., a banner ad) indicated by the ad information that was retrieved from the ad information database S1d, as discussed above.

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language below:

1. (previously presented): A system for incorporating ad information into e-mails, comprising:

...an ad information inserting section for:...

...inserting ad data contained in the retrieved ad information into the e-mail.

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site... comprising the steps of:

...inserting ad data contained in the retrieved ad information into the e-mail.

In view of the various embodiments discussed above, the present invention provides a system and a method for incorporating highly useful and effective ad information into e-mails while they are being exchanged.

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether or not claims 1-5 and 7-10 are patentable over U.S. Patent Application No. 2002/0063723 to Hirono (hereinafter “Hirono”), in view of U.S. Patent No. 6,360,221 to Gough et al. (hereinafter “Gough”) under 35 U.S.C. §103(a); whether or not claims 6 and 11 are patentable over Hirono, in view of Gough, and further in view of U.S. Patent No. 6,684,088 to Halahmi under 35 U.S.C. §103(a); and whether claims 12 and 13 are patentable over Hirono, in view of Gough, and further in view of U.S. Patent No. 6,505,203 to Adler under 35 U.S.C. §103(a).



## VII. ARGUMENT

As discussed above, the Examiner has rejected claims 1-5 and 7-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2002/0063723 to Hirono (hereinafter “Hirono”), in view of U.S. Patent No. 6,360,221 to Gough et al. (hereinafter “Gough”). Appellant disagrees with the grounds of rejection for *at least* the reasons set forth below.

### A. Independent Claim 1

Independent claim 1 requires (among other things):

...an area information detector for detecting  
whether an e-mail transmitted from the sending  
terminal contains area information or not...

The Examiner takes the position that Hirono teaches an area information detector for detecting whether information transmitted from a sending terminal contains area information or not. (01/04/05 Office Action, page 3). Further, the Examiner alleges that Gough teaches a system for incorporating ad information into e-mails. Thus, the Examiner alleges that it would have been obvious to one of ordinary skill in the art to combine the teachings of Hirono with those of Gough to arrive at the invention recited in claim 1.

Appellant disagrees. The grounds of rejection do not point to any specific portion of either Hirono or Gough that teaches the feature of an area information detector for detecting whether an e-mail transmitted from the sending terminal contains area information or not, as recited in claim 1.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations. (See MPEP § 2143). As a result, in order for the Examiner to maintain the above rejection under 35 U.S.C. §103, either Hirono, Gough, or some combination thereof, must teach or suggest all of the limitations of the claims. Since, the Examiner has not identified any portion of either Hirono or Gough that teaches or suggests an area information detector for detecting whether an e-mail transmitted from the sending terminal contains area information or not, as recited in claim 1, this rejection cannot stand.

By way of overview, Hirono teaches a system where a map can be displayed on a map home page, and that information such as an advertisement can also be displayed on the map home page. (Page 3, paragraph 0040). More particularly, Hirono teaches that a user inputs search parameters of a particular location to a map database 10, and that the created map image data is displayed on the map home page. (Page 3, paragraphs 0047-0048). Accordingly, Hirono teaches that advertisement image data is searched and obtained from an advertisement database 12, and is placed at a peripheral portion of the map on the map home page. (Page 3, paragraph 51).

In contrast to the requirements of claim 1, however, Hirono teaches that the user terminal 4 requests the home page server 1 for a map of a company or a store and, further, that this request is issued to the map home page server 2. (Page 4, paragraph 0064). Thus, Hirono teaches that the map home page server 2 executes a program for drawing a map corresponding to

the request from the user terminal 4. (Page 5, paragraph 0078). Finally, Hirono teaches that after the program creates the map image data, the created map image data is transmitted to the user terminal 4, which displays the map image data as the map image 44. (Page 5, paragraph 0078).

However, Hirono does not teach or suggest that the request sent from the user terminal 4 to the map home page server 2 comprises an e-mail. Further, contrary to the allegations in the grounds of rejection, Hirono does not even teach the feature of a detector for detecting whether the information transmitted from the user terminal 4 (i.e. the request for a map of a company or a store) contains area information. In fact, Hirono teaches nothing of the kind.

Claim 1 expressly requires the feature of detecting area information, which may include, for example, information regarding a geographic area such as a map, traffic facilities, or an address, which is inserted in addition to the body of an e-mail message. (Page 13, lines 4-8; page 14, lines 4-12). In contrast, Hirono merely teaches that the user terminal 4 sends a request, which is ultimately issued to the map home page server 2. (Page 5, paragraph 0078). But, Hirono fails to teach or suggest that any sort of detector which detects whether the request transmitted from the user terminal 4 contains area information, as recited in claim 1.

To the contrary, Hirono teaches just the opposite—that the map image data is created by the map home page server 2. Therefore, since Hirono teaches that the map home page server 2 creates the map image data, Hirono cannot possibly teach that the user terminal 4 transmits the map image data to the map home page server 2, or that the map home page server 2 detects

whether the request transmitted from the user terminal 4 contains the map image data. Hence, Hirono does not teach, and is incapable of suggesting, an area information detector for detecting whether an e-mail transmitted from the sending terminal contains area information or not, as recited in claim 1, and the Examiner has not established a *prima facie* case of obviousness for *at least* this reason.

Furthermore, the grounds of rejection have not identified any specific portion of Hirono that teaches detecting whether an e-mail contains area information or not, as recited in claim 1. Indeed, the Hirono reference is entirely unrelated to a process of sending e-mails, or sending e-mails with advertisements included therein. Moreover, Gough also fails to teach or suggest detecting whether an e-mail contains area information or not, as recited in claim 1, and the grounds of rejection have not pointed to any specific portion of Gough that teaches this feature.

To the contrary, Gough teaches an enhanced e-mail system wherein an e-mail may include an advertisement. (Column 5, lines 15-27; column 6, lines 22-25). However, Gough fails to provide any teaching or suggestion whatsoever that the e-mails transmitted therein may include area information, or regarding a detector that detects whether an e-mail contains area information or not, as recited in claim 1.

As a result, neither Hirono, Gough, nor any combination thereof teaches or suggests the feature of an area information detector for detecting whether an e-mail transmitted from the sending terminal contains area information or not, as recited in claim 1. Thus, Appellant respectfully submits that independent claim 1 is patentable over the applied references for *at*

*least* these independent reasons and respectfully requests that the Board overturn the Examiner's rejections.

Independent claim 1 also requires:

...an ad information inserting section for:  
retrieving position information on the  
area information..  
...retrieving, from said ad information  
database, ad information positioned in the  
display range of the area information indicated  
by the retrieved position information, based on  
the position data of ad information, and  
inserting ad data contained in the  
retrieved ad information into the e-mail.

The Examiner alleges that Hirono teaches all of the above features, except that Hirono fails to disclose the use of an e-mail system. Nevertheless, the Examiner applies Gough, which teaches a system for incorporating ad information into e-mails, and alleges that the combination of Hirono and Gough teaches or suggests all of the above features.

Appellant respectfully disagrees. As discussed above, Hirono teaches that advertisement image data is searched and obtained from an advertisement database 12, and is placed at a peripheral portion of a map that is created according to search parameters inputted by a user. (Page 3, paragraphs 0047-0048 and 0051). Hirono also teaches that the advertisement search can be linked to business categories that are relevant to the geographic particulars of the map viewed on the map home page. (Page 3, paragraph 0052 – page 4, paragraph 0053).

Thus, Hirono merely teaches displaying a map on a map home page, and that related advertisements may possibly be included along with the map. However, the linking of advertisements based on the geographic particulars of a map, which is selected by a user, as taught in Hirono, has no correlation whatsoever to an e-mail system. Further, such teachings do not correspond in any way to the feature of inserting ad information that is positioned in the display range of the area information contained in an e-mail message (i.e. area-specific advertisements based on the area information in an e-mail) as recited in claim 1.

Moreover, Gough does not cure the deficient teachings of Hirono. As already discussed, Gough teaches an enhanced e-mail system wherein an e-mail may include an advertisement. (Column 5, lines 15-27; column 6, lines 22-25). However, as taught in Gough, the advertisements included in an e-mail are not positioned in the display range of the area information contained in the e-mail message, as required by claim 1. Indeed, Gough does not provide any teaching or suggestion whatsoever that the inclusion of advertisements in e-mails is based on area information.

For instance, one embodiment of Gough teaches mass advertising e-mail, which is similar to spam e-mail (i.e., e-mails are sent directly from an advertiser to an e-mail user, even though not requested by the e-mail user). (Column 6, lines 18-28). Gough teaches that to avoid actual “spamming,” a paid membership service allows for a set mailing list to be provided to an advertiser. (Column 7, lines 1-12). Such a set mailing list will already have a predetermined amount of users, and the users may not all be from the same geographic location.

Significantly, according to the system taught in Gough, by using a set mailing list, there is never a determination or “detection” of area information in the e-mails once the e-mails have been sent from the sending terminal, nor will there ever be an insertion of an ad that is positioned in the display range of the area information contained in an e-mail message, as recited in claim 1. Quite the contrary, all e-mail accounts on the mailing list will get the advertisement regardless of whether or not any area information is contained in an e-mail message, and regardless of the display range of any such area information.

In another embodiment, Gough also teaches that advertising is determined based on how many times an e-mail message has been forwarded. For example, Gough teaches that an advertisement is provided with the first electronic message sent, but is not displayed to a user until after a predetermined number of instances in which the e-mail has been forwarded. (Column 15, lines 23-41). However, according to the system taught in Gough, the display of the advertisement is determined by how many times the message has been forwarded, and not determined by detecting whether an e-mail contains area information or not. Further, as taught in Gough, such advertisements are not positioned in the display range of any such area information, as recited in claim 1.

For *at least* the above reasons, Appellant submits that Gough provides no teaching or suggestion whatsoever to insert advertisements into an e-mail that are positioned in the display range of the area information contained in the e-mail. What is more, the Hirono reference is entirely unrelated to a process of sending e-mails, or sending e-mails with advertisements

included therein. Accordingly, Appellant respectfully requests that the Board overturn the Examiner's rejections for *at least* these reasons.

In addition, Appellant submits that one skilled in the art would not have been motivated to combine the teachings of Hirono, with those of Gough, to arrive at the present invention, and that the Examiner has not identified a proper motivation for doing so. When relying on several references, it is incumbent upon the Examiner to identify some suggestion to combine the references. In re Mayne, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997). As the proffered motivation for combining the teachings of Hirono with those of Gough, and for modifying such a combination to arrive at the present invention, the Examiner merely alleges that one skilled in the art would be motivated to incorporate the advertisement containing e-mails taught in Gough into the claimed invention of Hirono, "in order to provide free e-mail services for a member."

(08/24/04 Office Action, page 3).

However, the notion of providing "free" e-mails fails to modify the particular aspects of the e-mail system taught in Gough at all. Quite the contrary, the alleged combination provided by the Examiner is merely a free e-mail system, in addition to the separate use of a program where a user can have a map and advertisements displayed on a home page for a particular area of interest. Such a combination fails to teach or suggest the invention recited in claim 1. In particular, the Examiner has failed to provide any reason why, based on the teachings of Hirono and Gough, one skilled in the art would have been motivated to modify the e-mail system of Gough to provide advertisements positioned in the display range of the area information, as



recited in claim 1. Further, even if taken together, the combined teachings of Hirono and Gough nevertheless fail to teach or suggest the claimed invention.

Finally, with respect to the allegations set forth in the Examiner's Response to Arguments dated 01/04/05, Appellant directs the Board to the express language of claim 1. As set forth above, claim 1 recites the feature of inserting ad information into an e-mail. Claim 1 also recites the feature of retrieving ad information that is positioned in the display range of the area information detected in an e-mail. That is, claim 1 recites retrieving ad information based on the area information in an e-mail, and inserting such ad information into the e-mail.

Hence, the allegation in the Examiner's Response to Arguments dated 01/04/05, that claim 1 and all the subsequent claims fail to recite the feature of including advertisements based on geographic or area information, is without evidentiary support. Similarly, the Examiner's allegation that "area information is not geographical," is also without evidentiary support. To the contrary, as already discussed above, the specification makes clear that the area information that is contained in an e-mail message may include, for example, information regarding a geographic area such as a map, traffic facilities, or an address, which is inserted in addition to the body of an e-mail message. (Page 13, lines 4-8; page 14, lines 4-12). Therefore, Appellant submits that in light of the specification, no further clarification as to the definition of "area information" is necessary.

As such, Appellant respectfully requests that the Board overturn the Examiner's rejections for *at least* the reasons set forth above.

**B. Claims 2-5 and 12**

Since claims 2-5 and 12 are dependent upon claim 1, Appellant submits that these claims are patentable *at least* by virtue of their dependency.

**C. Claim 7**

Independent claim 7 recites (among other things):

...detecting whether an e-mail transmitted  
from the sending terminal contains area  
information...

Independent claim 7 further recites:

...retrieving position information  
corresponding to the area information contained  
in the e-mail...

...retrieving ad information positioned  
in the display range of said area information  
from an ad information database, where ad  
information containing ad data and position data  
of an ad provider is stored, the retrieved ad  
information being based on the position data and  
the position information of said retrieved area  
information; and

inserting ad data contained in the retrieved  
ad information into the e-mail.

In view of the similarity between these recitations and the recitations discussed above with respect to independent claim 1, Appellant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 7. As such, it is respectfully submitted that claim 7 is patentably distinguishable over Hirono, Gough, and any

combination thereof, *at least* for reasons analogous to those presented above. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections.

**D. Claims 8-10 and 13**

Since claims 8-10 and 13 are dependent upon claim 7, Appellant submits that these claims are patentable *at least* by virtue of their dependency.

**VIII. CONCLUSION**

In view of the foregoing differences between appealed claims 1-13 and the cited Hirono and Gough references, Appellant respectfully submits that the appealed claims are patentable over the cited references and requests that the Board overturn the Examiner's rejections.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

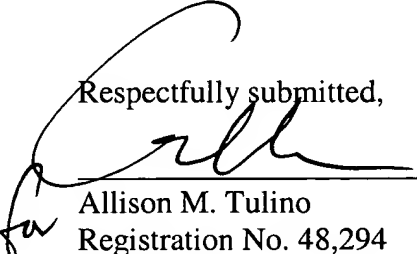
The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Respectfully submitted,  
  
Allison M. Tulino  
Registration No. 48,294  
Reg. No. 41,278

Date: June 6, 2005

**CLAIMS APPENDIX**

**CLAIMS 1-13 ON APPEAL:**

1. (previously presented): A system for incorporating ad information into e-mails, comprising:

at an e-mail site including an e-mail server for saving an e-mail transmitted from a sending terminal and transmitting the e-mail to a receiving terminal based on a transmission request made by the receiving terminal;

an area information detector for detecting whether an e-mail transmitted from the sending terminal contains area information or not;

a position information database that stores position information indicating the display range of area information displayed in the e-mail;

an ad information database where ad information containing ad data and position data of an ad provider is stored; and

an ad information inserting section for:

retrieving position information on the area information from said position information database when it is detected that the e-mail contains area information,

retrieving, from said ad information database, ad information positioned in the display range of the area information indicated by the retrieved position information, based on the position data of ad information, and

inserting ad data contained in the retrieved ad information into the e-mail.

2. (original): The system for incorporating ad information into e-mails according to claim 1, wherein said area information is display of a map, traffic facilities and/or an address.

3. (original): The system for incorporating ad information into e-mails according to claim 1, wherein position information stored in the position information database specifies the display range of area information by latitude and longitude.

4. (original): The system for incorporating ad information into e-mails according to claim 1, wherein ad data contained in the ad information stored in said ad information database is banner ad information.

5. (original): The system for incorporating ad information into e-mails according to claim 1, wherein position data contained in the ad information stored in said ad information database specifies the position of an ad provider by latitude and longitude.

6. (previously presented): The system for incorporating ad information into e-mails according to claim 1, further comprising a display format detector for detecting an area information display format of an e-mail at a receiving terminal as a source of an e-mail

transmission request when an e-mail transmission request is made by the receiving terminal or when the e-mail is transmitted to a destination e-mail server; and

a display format converter for converting the display format of the area information in the e-mail to be transmitted to the receiving terminal to the display format of the receiving terminal when it is detected that the display format of the receiving terminal differs from the display format of the area information in the e-mail transmitted from the sending terminal.

7. (previously presented): A method for incorporating ad information into e-mails at an e-mail site including an e-mail server for saving an e-mail transmitted from a sending terminal and transmitting the e-mail to a receiving terminal based on a transmission request made by the receiving terminal, said method comprising the steps of:

detecting whether an e-mail transmitted from the sending terminal contains area information;

retrieving position information corresponding to the area information contained in the e-mail from a position information database that stores position information indicating a display range of area information when it is detected that area information is contained in the e-mail;

retrieving ad information positioned in the display range of said area information from an ad information database, where ad information containing ad data and position data of

an ad provider is stored, the retrieved ad information being based on the position data and the position information of said retrieved area information; and

inserting ad data contained in the retrieved ad information into the e-mail.

8. (original): The method for incorporating ad information into e-mails according to claim 7, further comprising the step of specifying the display range of area information by latitude and longitude.

9. (original): The method for incorporating ad information into e-mails according to claim 7, further comprising the step of specifying the position of the ad provider of said ad data by latitude and longitude.

10. (original): The method for incorporating ad information into e-mails according to claim 7, further comprising the step of inserting said ad data into an e-mail transmitted from a sending terminal before saving the e-mail or before transmitting the e-mail to a destination e-mail server.

11. (previously presented): The method for incorporating ad information into e-mails according to claim 7, further comprising the steps of:



detecting an area information display format of an e-mail at a receiving terminal as a source of an e-mail transmission request when an e-mail transmission request is made by the receiving terminal or when the e-mail is transmitted to a destination e-mail server; and

converting the display format of the area information in the e-mail to be transmitted to the receiving terminal to the display format of the receiving terminal when it is detected that the display format of the receiving terminal differs from the display format of the area information in the e-mail transmitted from the sending terminal.

12. (previously presented): The system for incorporating ad information into e-mails according to claim 1, wherein the area information corresponds to an area of the receiving terminal.

13. (previously presented): The method for incorporating ad information into e-mails according to claim 7, wherein the area information corresponds to an area of the receiving terminal.

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**  
**U.S. Application No.: 09/850,114**

**Attorney Docket No.: Q64130**

**EVIDENCE APPENDIX**

This Appendix is not applicable to this Appeal.

**RELATED PROCEEDINGS APPENDIX**

This Appendix is not applicable to this Appeal.